Remarks

Reconsideration of this Application is respectfully requested.

Claims 1-9, 16-24, and 46-58 are pending in the application, with claims 1, 16, 46, and 53 being the independent claims. Claims 10-15 and 25-45 were canceled in a previous amendment. No amendments have been made.

Based on the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding rejections and that they be withdrawn.

Priority

The Examiner has noted that the present application 09/864,293 is a Continuation-In-Part (CIP) of Applications 09/559,964 and 09/393,390. The Examiner has alleged that this Application, 09/864,293, does not benefit from an earlier filing date due to inadequate support. (See Office Action, page 2). Applicants elect not to substantively respond to the Examiner's contentions at this time, but reserve the right to do so in the future.

Rejections under 35 U.S.C. § 103

Claims 1, 2, 4, 6, 7, 9, 16, 17, 19, 21, 22, and 24 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,516,341 to Shaw *et al.* ("Shaw") in view of U.S. Patent No. 5,848,396 to Gerace ("Gerace") in view of U.S. Patent No. 6,961,776 to Buckingham *et al.* ("Buckingham") in view of International Patent Application Publication No. WO 00/62463 to Pivowar *et al.* ("Pivowar"). Furthermore, claims 3, 5, 18, and 20 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shaw in view of Gerace in view of Buckingham in view of

Pivowar as applied above, in further view of U.S. Patent No. 5,794,210 to Goldhaber *et al.* ("Goldhaber"). Claims 8, 23, and 46-54 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shaw in view of Gerace in view of Buckingham in view of Pivowar as applied above, in further view of U.S. Patent No. 6,332,127 to Bandera *et al.* ("Bandera"). Claims 57 and 58 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shaw in view of Gerace in view of Buckingham in view of Pivowar in further view of U.S. Patent No. 5,933,811 to Angles *et al.* ("Angles"). Applicants respectfully traverse the rejections.

Independent claim 1 recites features that distinguish over the applied references, considered alone or in combination. For example, claim 1 recites:

> wherein the advertisement was received by the hand-held device from a server during a sync operation, wherein, during the sync operation, the hand-held device was placed into an adapter through which the hand-held device was coupled to the server.

Independent claims 16, 46, and 53 recite similar features as claim 1.

The Examiner appears to use Pivowar to allegedly teach or suggest this feature of claim 1. Pivowar appears to be directed to a system and method for providing advertising content during a data process. In the process, a connection is made with a server over a network and an advertising window is opened on a client computer. Advertising information is received from the server and is displayed in the advertising window. *See*, Pivowar, Abstract.

Figure 1 of Pivowar shows a system that includes a personal digital assistant (PDA) 102, a server 104, a computer 106 removably connected to PDA 102, and a

network 108. *See*, Pivowar, p. 4, lines 11-16. Computer 106 includes a microprocessor 110 and a display 116 among other components. *See*, Pivowar, p. 5, lines 5-6.

Server 104 is capable of synchronizing server data with personal data stored on PDA 102 over the communication link between sever 104 and PDA 102. During the synchronization process, a user must wait for the process to be completed before moving on to other tasks. "To effectively utilize this time period, the computer logic is adapted for controlling the processor to initiate the display of an advertisement page 300 upon the initiation of the synchronization process or any other local process run by processor 110." *See*, Pivowar, p. 5, lines 28-30. Advertisement 300 is displayed on display 116 of computer 106.

Thus, Pivowar describes a system in which a computer is used to couple a PDA to a server via a network. The information on the PDA is synchronized with a server. During the synchronization, advertising content is displayed on the computer.

Neither the portion of Pivowar cited by the Examiner, i.e., Figure 1, page 2, lines 20-30, and claim 1 of Pivowar, nor any other portion of Pivowar teaches or suggests the receipt of the advertisement by the hand-held device from a server during a sync operation, wherein, during the sync operation, the hand-held device is placed into an adapter through which the hand-held device is coupled to the server, as recited in claim 1.

Also, Pivowar does not teach or suggest advertising content being received by the hand-held device during a synchronization operation. Instead, as described above, the advertising content is displayed on the computer through which the PDA (e.g., the hand-held device) is coupled to the server during the synchronization process.

Furthermore, Pivowar also does not teach or suggest the PDA being placed into an adapter through which it is coupled to the server. Applicants note that Figure 1 does not include such an adapter through which the PDA is coupled to the server. Rather, at most, Figure 1 shows a link between the PDA and the computer. The PDA is also not placed into the computer, therefore the computer cannot be used to teach or suggest such an adapter.

> The coupling between the computer 106 and the server 104 may, in one embodiment, include a local or wide area network 108. One example of a network that may be employed for affording the foregoing coupling is the Internet. In other embodiments, other types of coupling may be employed including RF, fiber optic, or any type of transmission medium capable of transferring data and control signals. It should be understood that any of the foregoing types of coupling may also be employed for affording a link between the PDA 102 and the computer 106.
>
> (Pivowar, p. 5, lines 11-17).

Applicants note that none of the above-mentioned coupling means involves PDA 102 being placed into an adapter through which it is coupled to server 104.

Thus, because Pivowar does not teach or suggest: (1) advertising content being received by the hand-held device during the synchronization operation; and (2) having the hand-held device placed into an adapter through which the hand-held device is coupled to the server, Pivowar does not teach or suggest "wherein the advertisement was received by the hand-held device from a server during a sync operation, wherein, during the sync operation, the hand-held device was placed into an adapter through which the hand-held device was coupled to the server," as recited in claim 1.

Furthermore, Applicants assert that the applied references cannot be properly combined in such a way as to teach or suggest "wherein the advertisement was received by the hand-held device from a server during a sync operation, wherein, during the sync operation, the hand-held device was placed into an adapter through which the hand-held device was coupled to the server," as recited in claim 1. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *See*, M.P.E.P. § 2141.03 (VI) citing W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Pivowar teaches the display of advertisements on computer 106. Thus, Pivowar teaches away from a combination of the applied references that would result in the use of computer 106 to transmit advertising content from server 104 to PDA 102.

Therefore, for the above reasons, Applicants respectfully assert that claim 1 and its dependent claims are patentable over the applied references, considered alone or in combination. Moreover, Applicants respectfully assert that independent claims 16, 46, and 53 and their respective dependent claims are also patentable over the applied references for reasons similar to those described above with respect to claim 1.

Moreover, Applicants note that the Examiner has used at least four references to reject each of the pending independent claims. Applicants respectfully assert that the need to cite such a large of references to reject the claimed invention is an indication of the patentability of the invention, in view of the remarks presented above.

Accordingly, Applicants request that the rejections of claims 1-9, 16-24, and 46-58 be reconsidered and withdrawn.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Michael Q. Lee
Attorney for Applicants
Registration No. 35,239

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1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600

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